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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/361,118	07/27/99	WANTANABE	H Q55086

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2100 PENNSYLVANIA AVENUE  
WASHINGTON DC 20037-3213

EXAMINER

FIORILLA, C

ART UNIT	PAPER NUMBER
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1731

DATE MAILED:

09/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.

09/361,118

Applicant(s)

Watanab et al.

Examiner

Christopher A. Fiorilla

Group Art Unit

1731



☒ Responsive to communication(s) filed on Sep 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-12 is/are pending in the applicat

Of the above, claim(s) 9-12 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐Some\* ☒None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5,8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Applicant's election without traverse of Group I, claims 1-8 in Paper No. 10 is acknowledged.
2. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.
3. The abstract of the disclosure is objected to because it contains legal phraseology (i.e. "comprises" - lines 2,12 and 13). Correction is required. See MPEP § 608.01(b).
4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite. The first step recites "subjecting alumina powder...,resulting in slurry dispersed in a solvent". This is confusing since there is no indication as to how the powder is converted to a slurry, nor is there any previous reference to a solvent.

In claim 1, line 11, "having" should be changed to --has--.

In claim 1, last line "side" should be changed to --size--.

In claim 2, the phrase "wherein an alumina powder added a sintering agent" is confusing.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1,2,7 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mohri et al. (5,672,554).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohri et al. (5,672,554).

Mohri et al. teaches a method of producing a polycrystalline alumina sintered body. The process disclosed by Mohri et al. includes the steps of:

subjecting alumina powder to ultrasonic irradiation;  
forming a slurry from the powder;  
drying and forming the slurry; and sintering the slurry in air at the claimed temperatures.

Mohri et al. also discloses the addition of a sintering aid, such as MgO, to the alumina, and discloses the claimed alumina powder characteristics.

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Determination of the specific pore sizes, density and ingredient amounts would have been well within the realm of routine experimentation to one having ordinary skill in the art at the time of the invention. These parameters would have obviously been selected to optimize the process conditions (e.g. total sintering time) and/or the properties of the final product.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla, whose telephone number is (703) 308-0674. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached at (703) 308-3837.

Official after final faxes should be sent to (703) 305-3599. All other official faxes should be sent to (703) 305-7718. Unofficial faxes should be sent to (703) 305-7115.

Any inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is (703) 308-0651.

  
**Christopher A. Fiorilla**  
**Primary Examiner**  
**Technology Center 1700**  
**Art Unit 1731**